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OFFICE OF PETITIONS

ON PETITION

In re Application of
Kitamaru
Application No. 09/991,219
Filed: 16 November, 2001
Attorney Docket No.: 16869S-038000US

This is a decision on the petition filed on 7 April (supplemented on 17 July), 2003, to revive under 37 C.F.R. §1.137(a),¹ and in light of the allegations considered as a petition to withdraw the holding of abandonment under 37 C.F.R. §1.181.²

¹ A Petition filed under the provisions of 37 C.F.R. §1.137(a) must be accompanied by:

- (1) The required reply, unless previously filed. In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application for patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof;
- (2) the petition fee required by 37 C.F.R. §1.17(l);
- (3) A showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the reply due date until the filing of a grantable petition pursuant to the is paragraph was unavoidable; and
- (4) Any terminal disclaimer (and fee set forth in 37 C.F.R. §1.20(d)) required pursuant to 37 C.F.R. §1.137(c).

An application is "unavoidably" abandoned only where Petitioner (or Petitioner's counsel) takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, the response is not timely received in the Office. That is, in the context of ordinary human affairs the test is such care as is generally used and observed by prudent and careful persons in relation to their most important business. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (Comm'r Pat. 1913).

² The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

© When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor

For the reasons set forth below:

- the petition considered under 37 C.F.R. §1.181 to withdraw the holding of abandonment is **GRANTED**; and
- the petition under 37 C.F.R. §1.137(a) is **DISMISSED as moot**, and the fee \$110.00) refunded to Deposit Account 20-1430.

BACKGROUND

A review of the record reveals:

- it appeared that Petitioner failed to respond timely to the Notice to File Missing Parts (oath/declaration with surcharge) mailed on 7 December, 2001, with reply due (absent extension of time) on or before 7 February, 2002;
- the application went abandoned after midnight 7 February, 2002;
- no Notice of Abandonment was mailed before the instant petition was filed;
- more than a year later, Petitioner filed a Status Inquiry³ on 20 February, 2002;
- in response to the Status Inquiry, the Office forwarded to Petitioner copies of the Notice of Missing Parts and the Filing Receipt on 10 March, 2003;
- in support of the instant petition, Petitioner Robert C. Colwell (Reg. No. 27,431) provides records of his office, as well of the statement of Margaret K. Stephan of his office, in an effort to demonstrate non-receipt of the 7 December, 2001, Notice of Missing Parts;
- Petitioner included with the petition the authorization for the surcharge and with his supplement the balance of the reply to the Notice (oath/declaration).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the

act as a stay of other proceedings. * * *

³ Petitioner may find that copies of Status Inquiries (with companion date-stamped receipt cards) filed at six- (6-) month intervals provide strong evidentiary support for the showing of diligence required by Pratt and other case law (see: Fn. 1, above).

satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).⁴

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this congressional grant of authority.

The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁵

Delays in responding properly raise the question whether delays are unavoidable.⁶ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁷

And the Petitioner must be diligent in attending to the matter.⁸ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁹))

⁴ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

⁵ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁶ See: Changes to Patent Practice and Procedure; Final Rule Notice, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁷ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁸ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁹ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

CONCLUSION

Allegations as to the Request to Withdraw
the Holding of Abandonment and
the Petition Alleging Unavoidable Delay

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.¹⁰

Petitioner makes a satisfactory showing of non-receipt of the 12 December, 2001, Notice.

Accordingly, the petition:

- to withdraw the holding of abandonment as considered under 37 C.F.R. §1.181 hereby is **granted** and the fee is waived; and
- to revive as to unavoidable delay under 37 C.F.R. §1.137(a) hereby is **dismissed as moot**.

The instant application is forwarded to OIPE for processing before being forwarded for examination in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (703) 305-9199.



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¹⁰ See: Delgar v. Schulver, 172 USPQ 513 (D.D.C. 1971).